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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/595,204

06/16/2000

Naokazu Nagasawa

32739

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7590

10/31/2006

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EXAMINER

BRINEY III, WALTER F

ART UNIT

PAPER NUMBER

2615

DATE MAILED: 10/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/595,204	Applicant(s) NAGASAWA ET AL.	
	Examiner Walter F. Briney III	Art Unit 2615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 10-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4-6 and 13-15 is/are allowed.
- 6) ☒ Claim(s) 1-3, 7, 10 and 11 is/are rejected.
- 7) ☒ Claim(s) 12 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. **Claims 1, 2, 7, 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue (US Patent 6,618,586) in view of Sogaard Rasmussen, hereinafter Sogaard (US Patent 5,134,717), and further in view of Sone (US Patent 6,223,057).**

**Claim 1** is limited to "a telephone terminal device." In the previous rejections filed 18 May 2006 and 27 December 2005, both being hereby incorporated by reference, the above noted combination of Inoue, Sogaard and Sone was set forth to illustrate the obviousness of claim 1. In the instant reply by applicant, this claim was amended to recite that the "user selectable directories" are chosen by a "display means displaying a plurality of names corresponding to each of the plurality of user selectable directories." Heretofore this limitation has not been shown to be obvious, but is treated in detail below.

As previously noted it would have been obvious to modify Inoue in the manner taught by Sogaard for the purpose of expanding memory capacity and enabling number storage flexibility since numbers can be stored on a memory removable from the remainder of the terminal device and taken to another terminal device. The mechanism for storing numbers in the resulting terminal device requires selection of the storage address by entering the storage address, e.g. 00-99, with the numeric keypad.

In modifying the above combination, the ability to store numbers not simply in one index of a large range of addresses, but within an index of one of a plurality of

selectable subdivided ranges was added in the manner taught by Sone. In particular, Sone depicts in figure 5 that during telephone number registration a directory is selected in step 54. Figure 7 illustrates a GUI for enabling said selection between a plurality of user selectable directories, indexed as numbers one through four. See column 7, lines 17-38. The GUI corresponds to said "display means displaying a plurality of names corresponding to each of the plurality of user selectable directories." Therefore, Inoue in view of Sogaard and further in view of Sone makes obvious all limitations of the claim.

**Claim 2** is rejected for the reasons presented above concerning claim 1 as well as the reasons set forth in the Non-Final Office Action filed 27 December 2005.

**Claims 7, 10 and 11** are rejected for the reasons set forth in the Non-Final Office Action filed 27 December 2005.

2. **Claim 3** is rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue in view of Sogaard in view of Sone and further in view of Kurosawa (UK Patent Application 2,331,890).

**Claim 3** is rejected for the reasons presented above concerning claim 1 as well as the reasons set forth in the Non-Final Office Action filed 27 December 2005.

### ***Allowable Subject Matter***

The following is a statement of reasons for the indication of allowable subject matter:

3. **Claim 12 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.**

**Claim 12** is limited to "the telephone terminal device as claimed in any of claims 1, 4 or 10," as covered by Inoue in view of Sogaard and further in view of Sone. There is simply no teaching of or motivation to modify the cited prior art to allow a user to choose "in advance" one of the plurality of telephone directories "for automatically storing the telephone number stored in the temporary storage memory after making or receiving a call." Thus, claim 12 is allowable over the cited prior art.

4. **Claims 4-6 and 13-15 are allowed.**

**Claim 4** is allowable over the cited prior art for the same reasons presented in the Non-Final Office Action filed 27 December 2005.

**Claims 5 and 6** both depend solely on claim 4, and thus, are allowable over the cited prior art for at least the same reasons.

**Claim 13** is limited to "a telephone terminal device." This claim recites essentially the same limitations as claim 12, and thus, is allowable over the cited prior art for at least the same reasons.

**Claim 14** depends solely on claim 13, and thus, is allowable over the cited prior art for at least the same reasons.

**Claim 15** is limited to "a telephone terminal device." This claim recites essentially the same limitations as claim 4, and thus, is allowable over the cited prior art for at least the same reasons.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-3 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments with respect to claims 7, 10 and 11 have been considered but are unpersuasive.

With respect to claims 7, 10 and 11—the applicant alleges on page 10, lines 8-19, that the examiner's statement of motivation is "broad and generic" and "is not a legally sufficient motivation." The examiner respectfully disagrees: Providing external memory is stated as advantageous by Sogaard in column 1, lines 7-25. Namely, it expands initial system memory (i.e. extension) and it allows numbers to be transported between terminal devices (i.e. flexibility). Therefore, as all of the applicant's arguments have been shown to be either moot or unpersuasive, the rejections of claims 7, 10 and 11 are maintained.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Walter F. Briney III whose telephone number is 571-272-7513. The examiner can normally be reached on M-F 8am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sinh Tran can be reached on 571-272-7564. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**SINH TRAN**  
**SUPERVISORY PATENT EXAMINER**

WFB